



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,963	09/20/2001	Hiroshi Sumiyama	018775-842	1910
7590 Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404			EXAMINER HANG, VU B	
			ART UNIT 2625	PAPER NUMBER
			MAIL DATE 05/20/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/955,963

Applicant(s)

SUMIYAMA ET AL.

Examiner

Vu B. Hang

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

- This office action is responsive to the communication filed on 02/25/2009.
- Claims 1-16 are pending in the current application.

Response to Arguments

1. Applicant's arguments filed on 02/25/2009, with respect to the cited prior art Nishiyama et al. (US Patent 6,067,168), have been fully considered and are persuasive. Therefore, the previous rejections of Claims 1-26 have been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Takahasi et al. (US Patent 6,424,429 B1).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5-6, 8-11, 13-14 and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Takahasi et al. (US Patent 6,424,429 B1).
4. Regarding **Claims 1, 17 and 19**, Takahashi discloses an image forming apparatus (see Fig.1 and Col.1, Line 6-11), comprising: an input device for receiving image data as an input (see Fig.1 (11), Fig.4 (11) and Col.10, Line 43-52); a transfer portion for transferring the image data received by the input unit to an image memory of a memory-incorporating apparatus

connected to the input device via network (see Fig.1 (11,13,16), Fig.2 (24), Col.9, Line 9-12 and Col.11, Line 35-51); a memory recall key which generates a memory recall signal in direct response to pressing of the memory recall key by a user after a transfer of the image data received by the input device to the image memory of the memory-incorporating apparatus connected to the input device via the network for re-execution of an output instruction (see Fig.1 (11,13,16), Fig.3 (23f), Col.8, Line 61 – Col.9, Line 8 and Col.9, Line 24-33); a reception portion for receiving the image data stored in the image memory in accordance with the signal (see Fig.1 (11,16), Fig.2 (24,25) and Col.11, Line 43-59); and a printing device for forming an image with use of the image data received by the reception portion (see Fig.1 (11) and Col.10, Line 43-52).

5. Regarding **Claims 2 and 10**, Takahashi further discloses a retrieval portion for retrieving the image data in the memory of the memory-incorporating apparatus connected to the network (see Fig.1 (11,16), Fig.2 (24,25) and Col.11, Line 43-59).

6. Regarding **Claims 3 and 11**, Takahashi further discloses wherein the transfer portion transfers the image data to the image memory of the memory-incorporating apparatus retrieved by the retrieval portion (see Fig.1 (11), Fig. 2 (24,25), Col.9, Line 36-47 and Col.10, Line 43-52).

7. Regarding **Claims 5 and 13**, Takahashi further discloses a transfer instruction device for inputting a data transfer instruction in response to operation by a user (see Fig.3 (23b,23c,23d and Col.9, Line 24-33), wherein the retrieval portion retrieves the image data in the memory of the memory-incorporating apparatus when the data transfer instruction is inputted (see Fig.1 (11,16), Fig.2 (24,25) and Col.11, Line 43-59).

8. Regarding **Claims 6 and 14**, Takahashi further discloses wherein the memory recall key is displayed on a display device (see Fig.3 (23f) and Col.9, Line 24-33).

9. Regarding **Claims 8 and 16**, Takahashi further discloses wherein the memory recall key is displayed on the display device during or after the image forming operation by the printing device with use of the image data inputted by the input device (see Fig.3 (23f) and Col.9, Line 24-33).

10. Regarding **Claims 9, 18 and 20**, Takahashi discloses an image forming apparatus (see Fig.1 and Col.1, Line 6-11), comprising: a reading device for creating image data by reading an image document (see Fig.1 (11), Fig.2 (26) and Col.9, Line 9-23); a buffer for holding the image data created by the reading device (see Fig.2 (21,28) and Col.9, Line 9-23); a printing device for forming a copy of the image document on a sheet of paper based on the image data held in the buffer (see Fig.1 (11), Fig.2 (27) and Col.10, Line 43-52); a transfer portion for transferring the image data stored in the buffer to an image memory of a memory-incorporating apparatus connected to a network (see Fig.1 (11,13,16), Fig.2 (24), Col.8, Line 61 – Col.9, Line 8 and Col.11, Line 43-59); a memory recall key which generates a memory recall signal in direct response to pressing of the memory recall key by a user after a transfer of the image data received by the input device to the memory of the memory-incorporating apparatus connected to the input device via the network (see Fig.1 (11,13,16), Fig.3 (23f), Col.8, line 61 – Col.9, Line 8 and Col.9, Line 24-33); a reception portion for receiving the image data stored in the image memory in accordance with the signal (see Fig.1 (11,16), Fig.2 (24,25) and Col.11, Line 43-59); and a control unit for controlling the printing device which forms an image with use of the image data received by the reception portion (see Fig.1 (11), Fig.2 (21,27) and Col.10, Line 43-52).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 4, 7, 12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Nishiyama et al. (US Patent 6,067,168).

13. Regarding **Claims 4 and 12**, Takahashi discloses the image forming apparatus of Claims 1 and 9, but fails to disclose a warning device for informing a user that the retrieval portion cannot identify a memory-incorporating apparatus. Takahashi, however, teaches using a graphical user interface for communicating with the memory-incorporating apparatus (see Fig.3 and Col.9, Line 24-33). Nishiyama discloses an image forming apparatus that includes a warning device for displaying a message informing a user the presence of an external memory-incorporating device (see Fig.16 (S37), Fig.17a (121a) and Col.18, Line 43-49).

14. Takahashi and Nishiyama are combinable because they are from the same field of endeavor, namely image forming apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to include to Takahashi's image forming apparatus a warning device for informing a user that the retrieval portion cannot identify a memory-incorporating apparatus. The motivation would be to notify a user that an external memory-incorporating device is not present for image transferring.

15. Regarding **Claims 7 and 15**, Takahashi discloses the image forming apparatus of Claims 1 and 9, but fails to disclose wherein the memory recall key is displayed when the retrieval portion identifies a memory-incorporated apparatus, whereas the memory recall key is not displayed when the retrieval portion cannot identify a memory-incorporated apparatus.

Takahashi, however, teaches using a graphical user interface for communicating with the memory-incorporating apparatus (see Fig.3 and Col.9, Line 24-33). Nishiyama discloses an image forming apparatus that includes a warning device for displaying a message informing a user the presence of an external device (see Fig.16 (S37), Fig.17a (121a) and Col.18, Line 43-49). Nishiyama further teaches using a user interface to identify an external memory-incorporating device (see Fig.8a and Col.11, Line 7-12), and determining whether the memory-incorporating device is able or unable to store the image data upon request (see Fig.27 (118) and Col.32, Line 47-55).

16. At the time of the invention, it would have been obvious for one skilled in the art to include to Takahashi image forming apparatus a means for displaying the memory recall key when the retrieval portion identifies a memory-incorporated apparatus, and not displaying the memory recall key when the retrieval portion cannot identify a memory-incorporated apparatus. The motivation would be to enable the user to determine whether or not an external memory-incorporating device is available for image transferring.

17. Claims 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahasi et al. (US Patent 6,424,429 B1) in view of Anai (US Patent 5,663,800).

18. Regarding **Claims 21, 23 and 25**, Takahasi discloses the image forming apparatus as described in Claim 1 but fails to disclose wherein the image forming apparatus does not have an

image memory. Takahashi, however, discloses transferring the image data to an external memory-incorporated device for data storage and backup (see Fig.1 (11,13,16) and Col.8, Line 61 – Col.9, Line 8), and teaches that retrieving the stored image data from the external memory-incorporated device whenever required enables easy retrieval of image data without requiring complicated operations (see Col.2, Line 19-36). Anai discloses an image forming apparatus that does not have an image memory (see Fig.3 and Col.2, Line 7-22), and teaches that a no-memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus without complicated image data conversions (see Col.2, Line 7-22).

19. Takahashi and Anai are combinable because they are from the same field of endeavor, namely image forming apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to use an image forming apparatus that does not have an image memory. The motivation would be to increase the image processing efficiency. The a no-memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus, without complicated image data conversions (as taught by Anai).

20. Regarding **Claims 22, 24 and 26**, Takahasi discloses the image forming apparatus as described in Claim 9 bur fails to disclose wherein the image forming apparatus does not have an image memory. Takahashi, however, discloses transferring the image data to an external memory-incorporated device for data storage and backup (see Fig.1 (11,13,16) and Col.8, Line 61 – Col.9, Line 8), and teaches that retrieving the stored image data from the external memory-incorporated device whenever required enables easy retrieval of image data without requiring complicated operations (see Col.2, Line 19-36). Anai discloses an image forming apparatus that does not have an image memory (see Fig.3 and Col.2, Line 7-22), and teaches that a no-memory

image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus without complicated image data conversions (see Col.2, Line 7-22).

21. Takahashi and Anai are combinable because they are from the same field of endeavor, namely image forming apparatuses. At the time of the invention, it would have been obvious for one skilled in the art to use an image forming apparatus that does not have an image memory. The motivation would be to increase the image processing efficiency. The a no-memory image forming apparatus would enable for the image data to be immediately processed at the image forming apparatus, without complicated image data conversions (as taught by Anai).

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625